

RECEIVED
CENTRAL FAX CENTER

MAR 06 2006

PATENT
Docket No. 10383US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

TRUNG V. LE

Serial No.: 10/644,484

Filed: August 20, 2003

For: MEMORY CARD COMPATIBLE WITH
MULTIPLE CONNECTOR STANDARDS

Examiner: H. Nguyen

Group Art Unit: 2841

CERTIFICATE OF TELEFACSIMILE TRANSMISSION**Mail Stop AF**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450Examiner H. Nguyen
Fax No.: (571) 273-8300

Dear Sir:

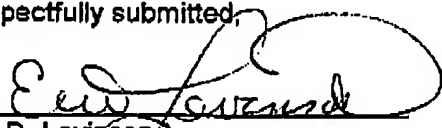
I certify that the following pages are being telefacsimile transmitted to the U.S. Patent and Trademark Office on the date shown below:

1. Notice of Appeal, in duplicate, with Certificate of Facsimile (2 pages)
2. Pre-Appeal Brief Request for Review, with Certificate of Facsimile (5 pages)
3. Petition for Extension of Time, in duplicate, with Certificate of Facsimile (2 pages)

Respectfully submitted,

Date

3/6/06


Eric D. Levinson
Reg. No. 35,814Imation Legal Affairs
P.O. Box 64898
St. Paul, Minnesota 55164-0898
Telephone: (651) 704-3604
Facsimile: (651) 704-5951**10 PAGES - INCLUDING COVER PAGE**

RECEIVED
CENTRAL FAX CENTER

MAR 06 2006

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Trung V. Le	Confirmation No.	7391
Serial No.:	10/644,484	Examiner:	Hung Thanh Nguyen
Filed:	August 20, 2003	Group Art Unit:	2841
Docket No.:	10383US01		
Title:	MEMORY CARD COMPATIBLE WITH MULTIPLE CONNECTOR STANDARDS		

CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being transmitted by facsimile to the Commissioner for Patents, Alexandria, VA 22313-1450 on March 10, 2006

By: Erie D. Levinson
Name: Erie D. Levinson

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests a Pre-Appeal Brief Request for Review, based upon the failure to establish a prima facie case of anticipation under 35 U.S.C. § 102 in the final Office Action mailed November 4, 2005. As outlined in greater detail below, the applied references fail to disclose or suggest claimed elements. For this reason, the anticipation rejections of claims 1, 7-10, 12-13, 15, 23, 25 and 27 are in error and must be reversed. Moreover, for the same reason, the obviousness rejections of dependent claims 11, 19 and 20 are in error and must be reversed.

For simplicity, Applicant has focused the arguments below on the pending independent claims. By setting forth these clear grounds of error, Applicant does not assert that these are the only errors in the final Office Action, nor does Applicant waive any arguments that may be asserted in an Appeal Brief. Accordingly, Applicant reserves the right to further address the dependent claims in the Appeal Brief.

In the Final Office Action, the Examiner rejected claims 1, 7-10, 12-13, 15, 23, 25 and 27 under 35 U.S.C. 102(b) as being anticipated by Kaneko (JP2002084930 or US 2003/0221066); and rejected claims 11, 19 and 20 under 35 U.S.C. 103(a) as being unpatentable over Kaneko in view of Jones et al. (US 6,438,638).

Applicant's pending claims concern memory cards that include two different connectors. In order to accommodate these two connectors, Applicant's pending claims recite a specific memory card architecture, which is fundamentally different than that taught by Kaneko. For this reason, the rejections under 35 U.S.C. 102 and 35 U.S.C. 103 are improper and must be reversed. Moreover, the Jones reference provides no teaching that would remedy the deficiencies of Kaneko with respect to the independent claims. Accordingly, the current rejections advanced by the Examiner are erroneous and should be reversed at this Pre-Appeal Brief stage of the Appeal process.

All pending claims recite a memory card that includes a first connector that conforms to a first connector standard and a second connector that conforms to a second connector standard. Claims 1 and 15 are independent claims directed to memory cards. Claims 23 and 27 are independent claims directed to systems that include a memory card and the first and second devices to which the memory card can be attached via the first and second connectors. The memory card recited in claim 1 is similar to that recited in system claim 23, while the memory card recited in claim 15 is similar to that recited in new system claim 27. All of these claims also require that the first connector standard comprises a host computer connector (HCC) standard and the second connector standard comprises a device communication connector (DCC) standard.

As noted by the Examiner in the Final Office Action, Kaneko teaches a memory card that includes two different connectors. For purposes of this abbreviated Pre-Appeal Brief Request for Review, Applicant does not dispute the Examiner's conclusions that Kaneko discloses a first connector that complies with a host computer connector (HCC) standard and a second connector that complies with a device communication connector (DCC) standard, as required by all pending claims.

However, the memory card of Kaneko is fundamentally different than those recited in Applicant's claims in another respect. In particular, Applicant's claims recite a different

Application Number 10/644,484
Pre-Appeal Brief Request for Review

controller architecture than that of Kaneko. Kaneko lacks any suggestion, whatsoever, of the controller architecture required by Applicant's different claims.

More specifically, claims 1 and 23 require that the memory card includes a controller that controls the memory and controls output via the first connector and the second connector. In stark contrast to this requirement of claims 1 and 23, Kaneko discloses a less efficient architecture that includes three different controllers. In particular, Kaneko discloses one controller for the memory, one for the first connector, and one for the second connector. None of the controllers of Kaneko, however, controls both the memory and output via the connectors, as required by claims 1 and 23.

Claims 15 and 27 require that the memory card include two controllers, i.e., first and second controllers. The first controller is electrically coupled to the memory and the first connector, and controls both the memory and output via the first connector. The second controller is electrically coupled to the second connector and the first controller, and the second controller controls output via the second connector.

Thus, claims 15 and 27 require two controllers, but one of the controllers controls both the memory and output via one of the connectors. This clearly distinguishes the claimed invention from Kaneko, which again, requires three different controllers for the memory, the first connector and the second connector, respectively. None of the controllers of Kaneko controls both the memory and output via a connector.

Applicant also respectively notes that the Examiner's analysis appears to overlook the different requirements of claims 15 and 27 relative to the requirements of claims 1 and 23. Indeed, the Examiner grouped all of claims 1, 15, 23 and 27 together in the analysis of the Final Office Action, notwithstanding the differences between claims 15 and 27 relative to claims 1 and 23. Thus, it appears that the Examiner may have overlooked the differences between claims 1 and 23 and Kaneko, as well as the differences between claims 15 and 27 and Kaneko.

In order to support an anticipation rejection under 35 U.S.C. 102, it is well established that a prior art reference must disclose each and every element of a claim. This well known rule

Application Number 10/644,484
Pre-Appeal Brief Request for Review

of law is commonly referred to as the "all-elements rule."¹ If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102 is improper.²

In this case, Kaneko does not disclose or suggest a controller that controls the memory and controls output via the first connector and the second connector, as required by claims 1 and 23. Furthermore, Kaneko does not disclose or suggest a controller that controls both the memory and output via one of two different connectors, as required by claims 15 and 27. In the context of a memory card that includes two different connectors (as also required by Applicant's claims), the controller architectures recited in the different claims, as discussed above, are novel and non-obvious over the applied prior art.

In view of the fundamental distinctions outlined above, all pending rejections are improper and must be reversed. The Jones reference provides no teaching that would remedy the deficiencies of Kaneko with respect to the independent claims. Therefore, Applicant reserves further comment on the Jones reference at this time.

As a final comment, Applicant respectfully notes that the arguments advanced in the Pre-Appeal Brief Request were formerly advanced in an After-Final Response, which appears to have been dismissed by the Examiner without any substantive comment. Applicant requests consideration by the Pre-Appeal Brief Board of the arguments above, which clearly demonstrate errors in the Examiner's final rejections.

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration by the Pre-Appeal Brief Board and reversal of all pending rejection.

¹ See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

² *Id.* See also *Lewmar Marine, Inc. v. Barient, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

Application Number 10/644,484
Pre-Appeal Brief Request for Review


Applicant also urges the Pre-Appeal Brief Board to recommend that the Examiner allow all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 09-0069.

Date:

3/6/06

Imation Legal Affairs
P.O. Box 64898
St. Paul, Minnesota 55164-0898
Telephone: (651) 704-3604
Facsimile: (651) 704-5951

By:



Name: Eric D. Levinson
Reg. No.: 35,814

BEST AVAILABLE COPY